

Applicant: Peter Osypka
Application No.: 10/759,791

REMARKS/ARGUMENTS

After the foregoing Amendment, Claims 1-9 are currently pending in this application. Claim 1 has been amended and new claim 9 has been added to more distinctly claim subject matter which the Applicant regards as the invention. Applicant submits that no new matter has been introduced into the application by these amendments.

Claim Rejections - 35 USC §103

Claims 1-4 and 6 were rejected in the Action under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 3,893,461 to Preston in view of U.S. Patent No. 4,919,135 to Philips Jr. et al. The Action specifically states that "Preston discloses a bipolar electrode comprising a cathode that may be attached to the distal end of lead 30 and an anode that may be attached to lead 30 proximal where the pacemaker connects to the lead 30. Preston further teaches the anode may be in the superior vena cava."

Applicant respectfully traverses the rejection. The claimed invention is an implantable bipolar stimulating electrode, comprising a cathode fixable within a patient's heart, an anode forming a second pole and at a distance to the cathode, and a connector for connecting the stimulating electrode to an implantable cardiac pacemaker, wherein at the cardiac pacemaker the connector is locatable outside of a

vein which leads to the heart and through which the stimulating electrode is guided to the working position. The anode is arranged near or on the connector on a side facing away from the cardiac pacemaker such that in the working position the anode is located between the connector and an entrance into the vein.

Preston actually teaches away from the claimed invention. As shown in Fig. 1, the catheter 20 is within the vein between points 52 and 50. This is not what is claimed, rather it is the exact opposite. The anode of the claimed invention is arranged on or near the connector and is arranged so that it is between the connector and the entrance to the vein when in its working position. It is thus outside the vein. Furthermore, Preston does not show or suggest an implantable cardiac pacemaker.

Philips Jr. et al also fails to show the arrangement of the claimed invention since both poles are separated by a great distance from the connector and from one another in the working position. Furthermore, Philips Jr. et al is not properly combinable with Preston since the connector of Philips Jr. et al is implantable and not external as are the electrodes of Preston. It is well settled that the fact that the prior art must be modified to produce the claimed invention does not make the claimed invention obvious unless there is something in the prior art to suggest the desirability of making such a modification. *In re Laskowski*, 10 USPQ2d 1397, 1398 (Fed.Cir. 1980). A rejection based on Section 103 must rest on a factual basis, with

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the facts being interpreted without hindsight reconstruction of the invention from the prior art.

The initial duty is on the USPTO to supply the factual basis for the rejection advanced. It is not permissive because of doubts that the invention is patentable, to resort to speculation, unfounded assumptions, or hindsight reconstruction to supply deficiencies in the factual basis. *Ex parte Havmond*, 41 USPQ2d 1217 (BdPatApp&Int 1996). That is, there must be some logical reason apparent from positive, concrete evidence of record which justifies a suggestion to modify a prior art structure. See *In re Regel*, 188 USPQ 136, 139 (CCPA 1975). No such evidence to combine the references was provided in this case, which merely combined the two references after reviewing the claimed subject matter.

Additionally, even if the references could be combined as suggested in the Action, the combination still fails to provide the anode located between the connector and the vein entrance.

Accordingly, withdrawal of the § 103 rejection of claim 1 is respectfully requested. Claims 2-4 and 6 depend from claim 1 and the rejection of those claims should be similarly withdrawn.

Claim 5 was rejected in the Action under 35 U.S.C. § 103(a) as being obvious over Preston in view of Phillips, Jr. et al and further in view of U.S. Patent No. 5,143,090 to Dutcher et al.

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Claim 5 depends from claim 1 and is believed to be allowable for at least the reasons stated above. Furthermore, Dutcher et al fails to remedy the deficiencies of Preston and Philips Jr. et al.

Accordingly, withdrawal of the § 103 rejection of claim 5 is respectfully requested.

Claims 7 and 8 were rejected in the Action under 35 U.S.C. § 103(a) as obvious over Preston in view of Phillips, Jr. et al and further in view of U.S. Patent No. 4,470,418 to Herscovici et al.

Claims 7 and 8 depend from claim 1 and is believed to be allowable for at least the reasons stated above. Herscovici et al also fails to remedy the deficiencies of Preston and Philips Jr. et al.

Accordingly, withdrawal of the § 103 rejection of claims 7 and 8 is respectfully requested.

Conclusion


If the Examiner believes that an interview, telephonically or in person, will materially advance the prosecution of this application, the Examiner is invited to contact the undersigned at the Examiner's convenience to arrange an interview.

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In view of the foregoing amendment and remarks, Applicants respectfully submit that the present application, including claims 1 - 9, is in condition for allowance and a notice to that effect is respectfully requested.

Respectfully submitted,

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